The present amendment is in response to the Office Action dated March 22, 2007. Claims 4-8, 10, 11, 14-25, 27-28, and 30-33 are now present in this case. Claims 29 and 34 have been canceled.

The Examiner will kindly note that representation in this matter has been transferred to another attorney. A revocation/substitute power of attorney is enclosed herewith

Rejection of Claims 4-8 and 27-34 as anticipated by Peck

Claims 4-8 and 27-34 stand rejected under 35 U.S.C. § 102(e), as anticipated by U.S. Patent No. 6,606,491 issued to Peck. Claims 29 and 34 have been cancelled.

Peck discloses a validation method for use with a dual-mode communication system (10) made up of an AMPS network (14) and a GSM network (12). The system (10) includes a plurality of dual-mode terminals (24) each equipped with a subscriber identity module ("SIM") card (90) and configured to communicate with both the AMPS network (14) and the GSM network (12).

According to the Background Section of Peck, in prior art systems, during an authentication process, a mobile terminal transmits a terminal authentication result ("AUTHR"), mobile identification number "MIN" (i.e., telephone number), and terminal-based electronic serial number "ESN" (i.e., device identifier) to a AMPS network. See Col. 2, lns. 12-22. The AUTHR is based on a Shared Secret Data ("SSD,") which is derived from the terminal-based ESN and an Authentification key (i.e., an A-key). *Id.* Upon receiving the transmission, the network uses the <u>MIN</u> to generate a network generated AUTHR that is compared to the received AUTHR to determine whether the two AUTHR values match. See Col. 2, lns. 22-26.

Peck discloses simply incorporating an additional key, a SIM-based ESN, into the generation of the terminal generated AUTHR. Specifically, in Peck, the AUTHR is based on the SSD <u>and</u> the SIM-based ESN. See Col. 7, lns. 36-39. Then, as in the prior art system, the mobile terminal transmits the AUTHR, MIN, and terminal-based

ESN to the AMPS network (14). See Col. 7, lns. 45-46. In other words, the dual-mode terminal (24) does <u>not</u> transmit the SIM-based ESN. Instead, the dual-mode terminal (24) transmits the AUTHR which is based on the terminal-based ESN keyed by both the A-key and the SIM-based ESN. Using two keys makes "an authentication algorithm, deemed safe today, virtually impossible to crack." See Col. 2, lns. 42-44. Transmitting one or both of keys is unwise because (1) the transmission of the key(s) consumes system resources unnecessarily transmitting information already resident in the system (see Col. 8, lns. 39-42) and (2) if the key(s) were intercepted during transmission, the key(s) could be used to unkey the keyed AUTHR and unlawfully gain access to the system.

　　　　　While the AUTHR is based on the SIM-based ESN, it is not properly characterized as a user identifier because it is merely a keyed version of the terminal-based ESN (i.e., the device identifier). Further, the SIM-based ESN is also <u>not</u> a user identifier because the SIM-based ESN is a <u>key</u>, like the A-key (mentioned above). See Col. 8, lns. 39-44. Instead of being used to identify the user, the SIM-based ESN is used in some sort of undisclosed keying operation performed by both terminal and the network to transform the terminal-based ESN into the AUTHR. Obviously, to locate the correct SIM-based ESN to use to generate the network generated AUTHR, the network must have made some previous determination as to the identity of the user or terminal (24), presumably using the MIN as described in the Background Section. In other words, the MIN is arguably disclosed as a user identifier that is used by the network to lookup or otherwise locate the SIM-based ESN (key) as well as the A-key.

　　　　　Independent claim 4 of the present application recites "a subscriber identity module (SIM), wherein the <u>user identifier</u> is associated with a serial number that, at least in part, is assigned to the SIM by a manufacturer of the SIM" and "a transmitter configured to <u>transmit the user identifier to a network</u>." If the "user identifier" is interpreted as corresponding to the MIN, Peck fails to anticipate the invention of claim 4 because the MIN is <u>not</u> "assigned to the SIM by a manufacturer of the SIM." On the other hand, the SIM-based ESN fails to anticipate the "user identifier" recited by claim 4 because the SIM-based ESN is a <u>key</u> and not a user identifier. Because Peck fails to teach a user identifier associated with a serial number that, at least in part, is assigned

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to the SIM by its manufacturer, Peck also fails to disclose a transmitter configured to transmit the user identifier. Therefore, because Peck fails to anticipate the invention of claim 4, applicant respectfully requests withdrawal of this rejection.

Claims 5-6, 27-28, and 30-33 depend from claim 4 and are patentable over Peck for all of the reasons provided above with respect to claim 4. Further, dependent claims 5-6, 27-28, and 30-33 recite additional elements that further distinguish them over the Peck reference. For example, claim 27 recites "the register is configured to store a mobile station number and the transmitter is configured to transmit the mobile station number and the user identifier to a network." According to the Office Action, the mobile station number corresponds to the MIN, which is transmitted to the network. However, as mentioned repeatedly above, Peck does not disclose transmitting the SIM-based ESN to the network. Further, Peck fails to disclose transmitting both the MIN and SIM-based ESN to the network. Therefore, applicant respectfully requests withdrawal of the rejection of claims 5-6, 27-28, and 30-33 as anticipated by Peck.

Independent claim 7 and claim 8 which depends from claim 7 both recite "a transmitter configured to transmit the SIM serial number to a network." As discussed above, Peck fails to disclose transmitting the SIM serial number to a network and therefore fails to teach a transmitter configured for such a transmission. Therefore, Peck fails to anticipate the inventions of claims 7 and 8 and applicant respectfully requests withdrawal of the rejection of claims 7 and 8 as anticipated by Peck.

Rejection of Claims 10, 11, and 14-25 as Obvious

Claims 10, 11, and 14-25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,310,889 issued to Parsons et al. in view of Peck. Each of these claims recites a user identifier based at least in part on a serial number of a SIM assigned by its manufacturer. As acknowledged in the Office Action, Parsons et al. fails to teach a user identifier based on a SIM serial number. As explained above, Peck also fails to teach a user identifier based on a SIM serial number. Consequently, combining Parsons et al. and Peck fails to teach this element of claims 10, 11, and 14-25.

Further, Peck teaches away from using the SIM-based ESN as a user identifier, as recited by claims 10, 11, and 14-25, because Peck discloses using the SIM-based ESN as a key. One of ordinary skill would not typically transmit a key alongside information keyed by the key because if the key is stolen during transmission, the key may be used to unkey (or decode) the information. If the key is to be kept secret and its transmission avoided, it cannot function as a user identifier. Because the teachings of Peck contradict using the SIM-based ESN as a user identifier, Parsons et al., Peck, and combinations thereof fail to render the inventions of claims 10, 11, and 14-25 obvious.

In view of the above amendments and remarks, reconsideration of the subject application and its allowance are kindly requested. The applicant has made a good faith effort to place all claims in condition for allowance. If questions remain regarding the present application, the Examiner is invited to contact the undersigned at (206) 757-8029.

Respectfully submitted,

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